

REMARKS

Claims 1-10 are pending in the application. Claim 3 has been amended.

Claim Amendments

Claim 3 has been amended to more clearly identify the active step of importing data, as opposed to the data simply being imported. No new subject matter has been entered by way of this amendment.

Rejections under 35 USC § 112, second paragraph

The Examiner has rejected claim 3 under 35 USC § 112, second paragraph, as being indefinite. Specifically, the Examiner asserts that the claim does not set forth any steps involved in the method/process, and that it is unclear what method/process Applicants are intending to encompass. Further, the Examiner asserts that Applicants did not address this issue and instead referred to claim 1. It seems to be the Examiner's position that, while claim 3 provides for the use of patient specific data, because claim 3 does not set forth any steps involved in the method/process, it is indefinite.

Applicants could not disagree more with this interpretation of the law. Applicants are unaware of any requirement that patent claims, which depend from an independent claim to a process, must themselves set forth an additional step in the process, where the independent claim includes at least one step. Further, Applicants fail to see why claim 3 is rejected for the reasons stated by the Examiner, while claims 4-9 are not.

However, without agreeing to the Examiner's interpretation of 35 U.S.C. § 112, second paragraph, with respect to process claims, Applicants have amended the language of claim 3 to include the step of "importing", such that claim 3 includes an active, positive step delimiting how the use is actually practiced.

In light of the present arguments and amendments, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 3 under 35 U.S.C. § 112, second paragraph.

Rejection of claim 3 under 35 U.S.C. § 101

The Examiner has rejected claim 3 under 35 USC § 101 because the claimed

recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process.

Again, without agreeing to the Examiner's interpretation of the law, Applicants have amended claim 3 to include the step of "importing". Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 3 under 35 U.S.C. §101.

Rejection of claims 1-10 under 35 USC § 102(e)

Claims 1-10 remain rejected under 35 USC § 102(e) as allegedly anticipated by Boland et al. (U.S. Pat. No. 7,051,654; hereinafter "Boland"). The Examiner asserts that the Declaration of Inventor Wei Sun under 37 C.F.R. § 1.131 (dated August 26, 2009) was not persuasive, presumably because it does not establish a "date of invention" of February 22, 2003, but merely establishes that the Applicants provided a drawing of a multi-nozzle printer to Mironov as of February 22, 2003. The Examiner has requested clarification, particularly as to whether the Applicants are alleging actual or constructive reduction to practice, and if actual reduction, whether it occurred prior to or subsequent to the effective date of the reference. The Examiner further asserts that the claimed invention is directed to more than "just a multi-nozzle printer".

Applicants respectfully submit that Boland does not anticipate claims 1-10 of invention for the following reasons. 35 U.S.C. § 102(e) provides that an applicant shall be entitled to a patent unless "the invention was described in ... a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent" Boland does not satisfy this requirement.

In view of the enclosed Declaration of Inventor Wei Sun under 37 C.F.R. § 1.131 (executed March 25, 2010), Boland does not anticipate claims 1-10, because the Applicants actually reduced to practice the invention prior to February 22, 2003, which is before the earliest date to which Boland might qualify as a prior art reference.

The present application, U.S. App. Ser. No. 10/540,968, is a national stage entry application of PCT/US04/15316, filed May 14, 2004, which claims priority from U.S. Provisional App. No. 60/520,272, filed November 14, 2003. Boland was filed on September 17, 2003, published on December 2, 2004, issued as a patent on May 5, 2006, and claims priority to U.S. Provisional App. No. 60/747,469 which was filed on May 30, 2003.

Boland is not a proper 35 U.S.C. §102(e) reference because Applicants of the present application invented and reduced to practice the apparatus, as well as the processes the apparatus performs, before Boland, as evidenced by the apparatus and the processes performed by the apparatus depicted in Figure 2a of Exhibit A, and the apparatus and the processes performed by the apparatus depicted in Exhibits B-D, prior to February 22, 2003, which is earlier than the earliest date that Boland could conceivably qualify as a prior art reference. Moreover, Applicants possessed descriptions of the structure and function of the apparatus depicted in Figure 2a of Exhibit A prior to February 22, 2003, and further provided such descriptions of the structure and function of the apparatus depicted in Figure 2a of Exhibit A to Vladimir Mironov before Mironov et al. was published, also as evidenced by the enclosed Declaration. Even assuming, *arguendo*, that the filing date of U.S. Provisional App. No. 60/747,469 is available as the critical date of the '654 patent under §102(e), that filing date occurs after February 22, 2003 and thus the '654 patent cannot anticipate the claims of the present application under §102(e).

In light of the present arguments, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-10 under 35 U.S.C. § 102(e).

Request for Examiner Interview

Applicants would like to express that the amendments and arguments presented herein and throughout prosecution of the present invention are made in good faith and with good intention, and further sincerely appreciate both the Examiner's past and continuing similar efforts. In the event that the Examiner does not believe the pending claims are in full condition for allowance, Applicants would greatly appreciate a telephonic interview with the Examiner to discuss the merits of the present application, prior to receiving a subsequent Office Action.

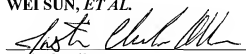
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Summary

Applicants respectfully submit that the arguments set forth herein evidence that the pending claims are in full condition for allowance. Accordingly, favorable examination of the claims is respectfully requested at the earliest possible time.

Respectfully submitted,

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